

REMARKS

I. Introduction

Claims **19, 23, 26, 28-29, 49**, and **53-63** are currently pending in the present application. Claims **19, 49**, and **53** are independent.

All pending claims (claims **19, 23, 26, 28-29, 49**, and **53-63**) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 4,654,800 (hereinafter “Hayashi”) in view of U.S. Patent No. 6,587,031 (hereinafter “Daugherty”).

Upon entry of this amendment, which is respectfully requested, new claims **64-83** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner’s Rejections

All pending claims (claims **19, 23, 26, 28-29, 49**, and **53-63**) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Hayashi in view of Daugherty. Applicants respectfully traverse this ground for rejection as follows.

A. The references fails to teach or suggest: *concealing the identity of the product from the consumer* (claims **19, 23, 26, 28-29, 49**, and **59-60**; generally)

Applicants respectfully assert that both Hayashi and Daugherty fail to teach or suggest, either alone or in combination, limitations of claims **19, 23, 26, 28-29, 49**, and **59-60**. For example, Hayashi and Daugherty fail to teach or suggest *concealing the identity of the product from the consumer* (a limitation generally recited by each of the above-listed claims).

The Examiner states that Hayashi fails to teach or suggest concealing the identity of the product vended to the consumer. Office Action mailed March 9, 2006 as Part of Paper No./Mail Date 20060301, pg. 3, last paragraph. Applicants agree. The Examiner goes on to state, however, that Daugherty makes up for this deficiency of Hayashi. Applicants respectfully disagree.

Daugherty does not involve vending machines whatsoever. Accordingly, Daugherty does not contemplate concealing the identity of *vended products*. Instead, Daugherty is directed to personal storage lockers (See, Abstract), such as are often found at airport terminals. Travelers may, for example, store personal belongings in such lockers for later retrieval, such belongings being concealed and protected in the lockers until the traveler returns to retrieve the belongings. Accordingly, Daugherty does not even contemplate products, as the contents of the lockers are personal belongings of individuals – not products offered for sale to consumers via the lockers. Further, at least because the travelers that own the belongings know what they put in the lockers, the “identity” of the items is not concealed to those individuals, instead, it is only the actual items themselves that are concealed. These teachings of Daugherty are not even reasonably related to the limitations of the pending claims that recite concealing vending machine product identities from consumers.

Accordingly, at least because Hayashi and Daugherty fail to teach or suggest *concealing the identity of the product from the consumer*, Hayashi and Daugherty fail to render claims **19, 23, 26, 28-29, 49, and 59-60** unpatentable. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **19, 23, 26, 28-29, 49, and 59-60** be withdrawn.

B. The references fails to teach or suggest: *selecting, by a vending machine, a product from among the plurality of products based on the monetary value and the minimum acceptable price data* (claims **19, 23, 26, 28-29, and 49**; generally)

Applicants respectfully assert that both Hayashi and Daugherty fail to teach or suggest, either alone or in combination, limitations of claims **19, 23, 26, 28-29, and 49**. For example, Hayashi and Daugherty fail to teach or suggest *selecting, by a vending machine, a product from among the plurality of products based on the monetary value and the minimum acceptable price data* (a limitation generally recited by each of the above-listed claims).

Hayashi simply does not contemplate a vending machine that selects products, much less basing such selections on money provided by a consumer and minimum price

data. The sections of Hayashi cited by the Examiner simply do not teach or suggest such a limitation. While Hayashi does describe storing and displaying some product and/or sales related data, Hayashi does nothing other than provide such data to the operators of the vending machine.

Daugherty utterly fails to make up for the deficiencies of Hayashi. As described herein, Daugherty is simply not directed to a vending machine or even directed to selling products.

Accordingly, at least because Hayashi and Daugherty fail to teach or suggest *selecting, by a vending machine, a product from among the plurality of products based on the monetary value and the minimum acceptable price data*, Hayashi and Daugherty fail to render claims **19, 23, 26, 28-29**, and **49** unpatentable. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **19, 23, 26, 28-29**, and **49** be withdrawn.

C. The references fails to teach or suggest: *determining, by a vending machine, a respective profit margin for each of a plurality of products* (claims **53-63; generally)**

Applicants respectfully assert that both Hayashi and Daugherty fail to teach or suggest, either alone or in combination, limitations of claims **53-63**. For example, Hayashi and Daugherty fail to teach or suggest *determining, by a vending machine, a respective profit margin for each of a plurality of products* (a limitation generally recited by each of the above-listed claims).

As described in Section II.B. herein, Hayashi does store some product and sales information. Hayashi does not, however, contemplate calculating profit margin information for the products sold by the vending machine. Simply nowhere does Hayashi describe such a metric being calculated or stored. Nor does Hayashi, as asserted by the Examiner, teach or suggest determining (i) a lowest profit margin (claim **57**), (ii) a highest profit margin (claim **58**), (iii) expiration data (claim **61**), or (iv) demand data (claim **62**); much less selecting products based on such data

Daugherty utterly fails to make up for the deficiencies of Hayashi. As described herein, Daugherty is simply not directed to a vending machine or even directed to selling products.

Accordingly, at least because Hayashi and Daugherty fail to teach or suggest *determining, by a vending machine, a respective profit margin for each of a plurality of products*, Hayashi and Daugherty fail to render claims **53-63** unpatentable. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **53-63** be withdrawn.

D. The references fails to teach or suggest: *select, by a vending machine, based on the respective profit margin for each of the plurality of products, a first product from among the plurality of products* (claims **53-63**; generally)

Applicants respectfully assert that both Hayashi and Daugherty fail to teach or suggest, either alone or in combination, limitations of claims **53-63**. For example, Hayashi and Daugherty fail to teach or suggest *select, by a vending machine, based on the respective profit margin for each of the plurality of products, a first product from among the plurality of products* (a limitation generally recited by each of the above-listed claims).

As described in Section II.B. herein, Hayashi does store some product and sales information, yet merely provides such information to the vending machine operator. Hayashi simply does not contemplate *selecting products based on profit margin*.

Daugherty utterly fails to make up for the deficiencies of Hayashi. As described herein, Daugherty is simply not directed to a vending machine or even directed to selling products.

Accordingly, at least because Hayashi and Daugherty fail to teach or suggest *select, by a vending machine, based on the respective profit margin for each of the plurality of products, a first product from among the plurality of products*, Hayashi and Daugherty fail to render claims **53-63** unpatentable. Applicants therefore respectfully request that this §103(a) ground for rejection of claims **53-63** be withdrawn.

E. No *Prima Facie* Case of Obviousness

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude Medical* 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The Examiner simply provides *no explanation*, reasoning, or support for the contention that it would have been obvious to combine Hayashi and Daugherty. In other words, even if Hayashi and Daugherty taught and suggested, in combination, every

limitation of the pending claims (which Applicants maintain they do not), the pending claims would nonetheless be allowable at least because the Examiner has not even attempted to set forth a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn.

F. Non-Analogous References

Daugherty is a reference pertaining to the art of personal and/or secure item storage. Daugherty is not related to vending machines, sales at vending machines, or even to sales at all. Nor is Daugherty directed to solving any problem coincident with either the present disclosure or Hayashi.

Accordingly, at least because Hayashi and Daugherty are directed to different fields of endeavor and are not directed to solving the same problem, Hayashi and Daugherty are non analogous references and Applicants therefore respectfully request that this §103(a) ground for rejection be withdrawn.

III. New Claims

New claims **64-83** are believed to be patentable over the cited reference at least for the reasons otherwise presented herein. Further, after reviewing the cited reference, Applicants believe that the cited reference fails to teach, suggest, or render obvious at least:

(i) *selecting, by a processing device of the vending machine, one of the plurality of products to be offered as a mystery product, wherein the selection is based at least in part on data associated with the selected product (claims 64-71);*

(ii) *calculating, by the processing device, a mystery product price for the selected mystery product, wherein the mystery product price is greater than a pre-determined minimum acceptable price for the mystery product and less than the retail price associated with the mystery product (claims 64-71);*

(iii) *displaying an offer for the mystery product to consumers, the offer comprising an indication of the mystery product price, and wherein the offer does not comprise an indication of the identity of the mystery product (claims 64-71);*

(iv) *wherein the offer comprises an indication of a category associated with the mystery product (claim 65);*

(v) *wherein the data associated with the mystery product comprises an expiration date of the mystery product (claim 66);*

(vi) *wherein the data associated with the mystery product comprises a stock date of the mystery product (claim 67);*

(vii) *wherein the data associated with the mystery product comprises a sales rate of the mystery product (claim 68);*

(viii) *wherein the data associated with the mystery product comprises an inventory of the mystery product (claim 69);*

(ix) *wherein the data associated with the mystery product comprises a profit margin of the mystery product (claims 70);*

(x) *wherein the data associated with the mystery product comprises at least two of: an expiration date of the mystery product; a stock date of the mystery product; a sales rate of the mystery product; an inventory of the mystery product; and a profit margin of the mystery product (claim 71);*

(xi) *displaying, via a display device of a vending machine, an offer for a mystery product, wherein the offer only identifies a category associated with the mystery product and a mystery product price associated with the mystery product (claims 72-75);*

(xii) *wherein the category comprises a “snack” category (claims 73 and 79);*

(xiii) *wherein the category comprises a “drink” category (claims 74 and 79);*

(xiv) *selecting, by the processing device, the mystery product from a plurality of available products offered for sale by the vending machine, wherein the mystery product is selected from a subset of the available products that are associated with the displayed category (claim 75);*

(xv) *displaying, via a display device of a vending machine, an offer for a mystery package comprising a first mystery product and a second mystery product, wherein the offer only identifies (i) a first category associated with the first mystery product, (ii) a*

second category associated with the second mystery product, and (iii) a mystery package price associated with the mystery package (claims 76-79);

(xvi) selecting, by the processing device, the first mystery product from a first subset of a plurality of available products offered for sale by the vending machine, the first subset being associated with the first category; and selecting, by the processing device, the second mystery product from a second subset of a plurality of available products offered for sale by the vending machine, the second subset being associated with the second category (claim 77);

(xvii) selecting, by a processing device of the vending machine, and based on the product category selected by the consumer and the monetary amount provided by the consumer, a mystery product associated with the product category, wherein a minimum price associated with the mystery product is less than or equal to the monetary amount provided by the consumer (claim 80);

(xviii) identifying a product offered for sale by the vending machine that is associated with a minimum acceptable price that is less than or equal to the amount of change due to the consumer and offering the identified product to the consumer as a mystery product in exchange for the amount of change due to the consumer (claim 81);

(xix) determining, by the point-of-sale terminal, a rounded price, the rounded price comprising a nearest whole dollar amount greater than the purchase price and determining, by the point-of-sale terminal, a round-up amount, the round-up amount comprising a difference between the purchase price and the rounded price and determining, by the point-of-sale terminal, an upsell offer that corresponds to the round-up amount (claim 82); or

(xx) dispensing, after the receiving of the indication of acceptance of the upsell offer, the first product and the upsell product to the consumer (claim 83).

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

V. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

June 9, 2006
Date

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